

superficial body growths, wherein said metabolic derivative thereof is selected from the group consisting of 5-androstene-3 β ,17 β -diol, 5-androstene-3 β ,17 β -diol sulfate and 4-androstene-3,17-dione.

Please cancel Claims 15 and 26.

Please cancel Claims 34 and 35.

SUPPORT FOR AMENDMENTS

The amendments to Claims 12 and 23 are supported by original Claims 15 and 26, now canceled. These amendments should be entered as they present no new issues, and raise no new matter.

REMARKS

The above amendments address the rejection regarding the term “derivative” by specifying the particular metabolic derivatives of DHEA in the remaining independent claims. Accordingly, this rejection should be withdrawn.

Claims 1 and 2 have been canceled, rendering moot the anticipation rejection over Hadley. Remaining independent Claims 12 and 23, and claims dependent thereon, are not rendered obvious by the combination of Hadley and Breton.

Claim 12 relates to a method of depigmenting and/or bleaching of the skin, and/or improving the homogeneity of the color of the skin. Claim 23 relates to a method of pro-pigmenting superficial body growths. Both claims use DHEA or a biological precursor thereof, or a specific metabolic derivative thereof.

Taking Claim 23 first, which is related to pro-pigmenting superficial body growths, Applicants respectfully submit that neither Hadley or Breton nor their combination disclose

or suggest such a method. Breton discloses the use of S-DHEA for treating wrinkles and fine lines, and for firming skin tissue, imparting radiance to old skin, treating slackening, etc. See the paragraphs under the “SUMMARY OF THE INVENTION” section bridging columns 1 and 2 of the reference. No disclosure or suggestion relating to superficial body growths such as hair is provided by Breton, nor is there any suggestion that superficial body growths may be pro-pigmented as described in present Claim 23.

Hadley was primarily cited for its discussion of the administration of estrogens. In addition, Hadley discloses a passage on androgens, and it is admitted that Hadley does not specifically teach the topical administration of androgens. Although the Office takes the position that Hadley teaches the administration of an androgen in a general way “that in no way excludes or teaches away from topical administration,” this is not a teaching of topical administration. Moreover, and in any event, there clearly is no discussion in Hadley regarding the application of androgens to superficial body growths such as hair. The Hadley passage on androgens relates to the skin of rats and hamsters, concerning melanization and pigmentation.

Accordingly, even the combination of Hadley and Breton cannot form a supportable *prima facie* case of obviousness against present Claim 23, which is directed to a method of pro-pigmenting superficial body growths, and this rejection should be withdrawn.

Present Claim 12 relates to a method of depigmenting and/or bleaching of the skin, and/or improving the homogeneity of the color of the skin, by applying DHEA, etc. to the skin. As noted above, the Office has admitted that Hadley does not specifically teach topical administration of androgens, and sets out a further position that the phrase “administration of an androgen” does not exclude or teach away from topical administration. However, and as pointed out above, not excluding something is not the same thing as actually teaching or

suggesting something, and it is a positive suggestion that is necessary to provide the motivation required by 35 U.S.C. §103 to present a supportable combination of references. Regardless, Hadley is clearly directed to *increasing* the pigmentation in skin, no matter how the androgen is administered, and thus cannot be used as evidence supportive of a conclusion that a method of depigmenting and/or bleaching of the skin, or improving the homogeneity of the color of the skin, is obvious. Breton does not make up for that lacking in Hadley regarding method Claim 12, as this reference similarly fails to disclose depigmenting and/or bleaching of the skin, or improving the homogeneity of the color of the skin. Again, see the "SUMMARY OF THE INVENTION" section of the reference bridging columns 1 and 2 thereof.

Accordingly, and for the reasons presented above Applicants respectfully submit that the pending claims are in condition for allowance, and early notification to this effect is respectfully requested. Should any further issues remain that would place this case in condition for allowance the Examiner is requested to contact Applicant below-signed attorney by telephone.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



22850

Telephone: (703) 413-3000

Facsimile (703) 413-2220

I:\atty\RLT\196726.amendment.wpd

Richard L. Treanor
Attorney of Record
Registration No.: 36,379

DOCKET NO.: 196726US0
SERIAL NO.: 09/686,997

MARKED-UP COPY OF AMENDED CLAIMS
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Please amend Claim 12 as follows:

--12. (Amended) A method of depigmenting and/or bleaching [for] of the skin and/or to improving the homogeneity of the color of the skin, comprising applying DHEA or at least one biological precursor thereof or metabolic derivative thereof to the skin, wherein the metabolic derivative thereof is selected from the group consisting of 5-androstene-3 β ,17 β -diol, 5-androstene-3 β ,17 β -diol sulfate and 4-androstene-3,17-dione.--

Please amend Claim 23 as follows:

--23. (Amended) A method of pro-pigmenting superficial body growths, comprising applying DHEA or at least one biological precursor thereof or metabolic derivative thereof to superficial body growths, wherein said metabolic derivative thereof is selected from the group consisting of 5-androstene-3 β ,17 β -diol, 5-androstene-3 β ,17 β -diol sulfate and 4-androstene-3,17-dione.--

Claims 1- 11 (Canceled)

Claims 15 and 26 (Canceled)

Claims 34 and 35 (Canceled)